

ESTTA Tracking number: **ESTTA501273**

Filing date: **10/22/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91206945
Party	Defendant Mayfair Brands (Ireland) Ltd
Correspondence Address	MAYFAIR BRANDS (IRELAND) LTD DOCKLANDS INNOVATION PARK, UNIT 35 DUBLIN 3, IRELAND roger.hatfield@mayfairbrands.com
Submission	Answer
Filer's Name	Mark S. Leonardo
Filer's e-mail	ip@brownrudnick.com
Signature	/Mark S. Leonardo/
Date	10/22/2012
Attachments	29901-2_Answer_to_Notice_of_Opposition.pdf ( 5 pages )(77058 bytes )

**THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application:

Serial No. : 85/483,341  
Filed : November 30, 2011  
Trademark : PROVIDENCIA  
Published : May 15, 2012

ETABLISSEMENTS JEAN-PIERRE MOUEIX,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91206945
	)	
MAYFAIR BRANDS (IRELAND) LTD.,	)	
	)	
Applicant.	)	
	)	

**ANSWER TO NOTICE OF OPPOSITION**

Applicant, Mayfair Brands (Ireland) Ltd., hereby answers Opposer, Etablissements Jean-Pierre Moueix's, Notice of Opposition, responding to the individual allegations therein as follows:

1. Applicant admits that it filed application Serial No. 85/483,341 and states that those documents speak for themselves.
2. Paragraph 2 states a legal conclusion to which no response is required. Applicant is otherwise without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 2 of the Opposition, and therefore denies same and calls for strict proof thereof.

3. Paragraph 3 states a legal conclusion to which no response is required. Applicant is otherwise without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 3 of the Opposition, and therefore denies same and calls for strict proof thereof.

4. Paragraph 4 states a legal conclusion to which no response is required. Applicant is otherwise without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 4 of the Opposition, and therefore denies same and calls for strict proof thereof.

5. Paragraph 5 states legal conclusions to which no response is required. To the extent that Paragraph 5 states any factual allegations or otherwise requires a response, Applicant denies the allegations.

6. Paragraph 6 states legal conclusions to which no response is required. To the extent that Paragraph 6 states any factual allegations or otherwise requires a response, Applicant denies the allegations.

7. Paragraph 7 states a legal conclusion to which no response is required. To the extent that Paragraph 7 states any factual allegations or otherwise requires a response, Applicant denies the allegations.

8. Paragraph 8 states a legal conclusion to which no response is required. To the extent that Paragraph 8 states any factual allegations or otherwise requires a response, Applicant denies the allegations.

## **AFFIRMATIVE DEFENSES**

### **FIRST DEFENSE**

Opposer's Notice of Opposition fails to state a claim on which relief can be granted.

### **SECOND DEFENSE**

On information and belief, Opposer's claims are barred by the doctrine of laches, estoppel, acquiescence and/or waiver in relation to the genericness of the mark and numerous third party uses of the word "Providence" and registrations of marks including the word "Providence" on or in connection with a wide variety of goods and services that have no affiliation with Opposer.

### **THIRD DEFENSE**

Opposer's mark pled in the Notice of Opposition is not confusingly similar in appearance, sound or connotation to Applicant's PROVIDENCIA, Serial No. 85/483,341, for alcoholic beverages except beers; rum, and therefore there is no likelihood of confusion as to the source of goods.

#### **FOURTH DEFENSE**

Opposer's mark pled in the Notice of Opposition is registered for goods/services that are not related to Applicant's stated goods. Opposer's associated goods are not sold to the same or similar class of purchasers, as the goods, specifically, wine, is not likely to cause confusion in the marketplace as to the source of goods.

#### **FIFTH DEFENSE**

There is no likelihood of confusion, mistake or deception because, *inter alia*, Applicant's mark and the mark of Opposer are not confusingly similar. Any trademark rights that Opposer may have are narrowly circumscribed to the goods indicated and any other use would not lead to a likelihood of confusion.

#### **SIXTH DEFENSE**

Opposer has waived the claims not contained in its Notice of Opposition.

#### **SEVENTH DEFENSE**

Applicant hereby reserves its right to assert any and all other defenses as appropriate as they present themselves through the course of this proceeding.

WHEREFORE, Applicant, Mayfair Brands (Ireland) Ltd., respectfully prays that this Board dismiss the Notice of Opposition, remand the Application for issuance of the registration, and grant such other and further relief as the Board deems just and proper.

Dated: October 22, 2012

Respectfully submitted,  
MAYFAIR BRANDS (IRELAND) LTD.  
By its attorneys,  
/Mark S. Leonardo/  
Mark S. Leonardo  
Brown Rudnick LLP  
One Financial Center  
Boston, Massachusetts 02111  
(617) 856-8145  
ip@brownrudnick.com

#### **CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing Answer to Notice of Opposition was served upon Attorney for Opposer on October 22, 2012, via First Class Mail, postage prepaid to:

Julie B. Seyler  
Abelman Frayne & Schwab  
666 Third Avenue  
New York, NY 10017

and via electronic mail to:

[jbseyler@lawabel.com](mailto:jbseyler@lawabel.com)

/Mark S. Leonardo/  
Mark S. Leonardo  
Brown Rudnick LLP  
One Financial Center  
Boston, Massachusetts 02111  
(617) 856-8145  
[ip@brownrudnick.com](mailto:ip@brownrudnick.com)